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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,052	01/26/2001	Veijo Vantinen	324-010115-US(PAR)	7249

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EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,052

Applicant(s)

VEJJO VANTTINEN

Examiner

Naghmeh Mehrpour

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 9/22/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-34 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/771,464. Although the conflicting claims are not identical, they are not patentably distinct from each other because both application are the method for coordinating the use of beam forming between two communicating entities wherein control information regarding the use of beam forming is communicated between the two entities, and the claims 1-34 limitation of instant application is encompassed by the claims 1-24 limitation of the Application. The claims limitation of the instant application are broad enough to be encompassed by the limitation of the application and as such it would have been obvious to one of ordinary skill in the art to

Art Unit: 2686

implement the invention of the claims of the instant application using the claims of the application for beam forming coordination.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-16, 18-33**, are rejected under 35 U.S.C. 102(e) as being anticipated by Naghian et al. (US Patent Number 2002/0086682 A1).

Regarding claims 1, 18, Naghian teaches a method/packet-switched radio system comprising:

a network part of the radio system (see figure 4, 10), which comprises a core network (SGSN, 3G-MSC, GMLC-HLR) (see figure 1, 14, 12) and a radio network 10 connected to the core network 41/40 (see figure 4), a radio UM connection from the radio network to a subscriber terminal 7 (UM, see figure 4, page 2 section 0027); and

the network part comprising location service (see figure 4) means for locating the subscriber terminal 7 (page 3 section 0053); and

Art Unit: 2686

the subscriber terminal 7 comprises means for transmitting a request message for location service to the core network via the radio network (page 3 section 0036);

the network part comprises means for performing at least one function required in the request message and means for transmitting a response message to the subscriber terminal via the radio network (see figure 4, page 3 section 0042).

Regarding claims 2, 19, Naghian teaches a method/a radio system wherein the request message relates to one of the following location service functions (page 6 section 0110):

determination of the subscriber terminal location, informing of an outside client of the radio system of the subscriber terminal location, transmission of location assistance data to the subscriber terminal (page 6 section 0117).

transmission of a ciphering key for decrypting the location assistance data to the subscriber terminal. (page 9 section 0180).

Regarding claims 3, 20, Naghian teaches method/a radio system wherein the information included in the request message comprises desired quality of service of the requested location service (page 5 section 0088).

Regarding claims 4, 21, Naghian teaches a method/a radio system wherein the other information comprises at least one of the following parameters:

receiving power of the serving cell (page 4 section 0060), receiving power of at least one neighboring cell, charge level of the battery in the subscriber terminal, information on the

Art Unit: 2686

conditions at the location of the subscriber terminal, identity of a separate device connected to the subscriber terminal.

Regarding claims 5, 22, Naghian teaches a method/a radio system wherein the subscriber terminal comprises means for inserting at least part of the information included in the request message received by the core network (see figure 4) into the request message (page 3 section 0042).

Regarding claims 6, 23, Naghian teaches a method/a radio system wherein the radio network comprises means for inserting at least part of the information included in the request message received by the core network into the request message (page 3 section 0042).

Regarding claims 7, 24, Naghian teaches a method/a radio system wherein, if the function is location of the subscriber terminal, a special location procedure will be performed (page 2 section 0031). More accurate location information can be obtained through a differential GPS.

In addition to the GPS, any other similar system capable of providing reliable location information can be used for this. There are several other proposals for providing location information that is more accurate than the information that is based on cell coverage area. It is also possible to have a system where several different location service accuracy classes are provided, wherein the method used for the location determination depends of the requested accuracy. For special location procedures, the required accuracy may be indicated e.g. by so

Art Unit: 2686

called quality of service (QoS) parameters included in a location information request (page 5 section 0088).

Regarding claims 8, 25, Naghian teaches a method/a radio system wherein the core network comprises means for locating the subscriber terminal on the basis of the information included in the request message (page 3 section 0042).

Regarding claims 9, 26, Naghian teaches a method/a radio system, wherein the procedures required by the location service comprise receiving signals in the subscriber terminal and measuring them, or transmitting signals from the subscriber terminal (page 4 section 0061).

Regarding claims 10, 27, Naghian teaches method/a radio system wherein the signals received in the subscriber terminal to implement the location service comprise signals transmitted by the radio system including signals transmitted by other base stations of the radio system than by that of the serving cell, or the signals transmitted by a satellite of the GPS system (page 2 section 0031).

Regarding claims 11, 28, Naghian teaches method/a radio system wherein the network part of the radio system comprises means for checking whether the location of the subscriber terminal carried out corresponds to the target set for the quality of service (page 5 sections 0088).

Art Unit: 2686

Regarding claims 12, 29, Naghian teaches a method/a radio system wherein, if the target set for the quality of service is not achieved, the network part will perform a location service, which offers a better quality of service (page 5 section 0088).

Regarding claims 13, 30, Naghian teaches a method/a radio system wherein tracing of the route traveled by the subscriber terminal is performed so that the subscriber terminal 40 at regular intervals transmits a request message requesting location of the subscriber terminal (page 4 section 0044).

Regarding claims 14, 31, Naghian teaches a method/a radio system wherein tracing of the route traveled by the subscriber terminal is performed so that one parameter to be added to one location request is a definition of the need to determine the location of the subscriber terminal at regular intervals (page 7 sections 0140, 0141).

Regarding claims 15, 32, Naghian teaches a method/a radio system wherein the outside client of the radio system is informed of the location of the subscriber terminal by the core network, by the subscriber terminal (page 7 section 0129).

Regarding claims 16, 33, Naghian teaches a radio system wherein the response message contains at least one of the following pieces of information: the location of the subscriber terminal, location assistance data, a ciphering key for decrypting the location assistance data

Art Unit: 2686

(page 9 section 0180), an error code, information on whether location information on the subscriber terminal is to be submitted to an outside client.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 17, 34**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Naghian et al. (US Patent Number 2003/0148774) in view of Korpela (US Patent Number 6,311,055).

Regarding claims 17, 34, Naghian fails to teach a method/a radio system wherein the request message and the response message are messages of protocol layers that correspond to the third layer of the OSI model. However Korpela teaches wherein the mobile of third generation known by universal mobile telecommunications system (UMTS) transferred amount of data most preferably in the radio resource control (LLC) of layer 3 structure according to International Standardization Organization (OSI) (col 4 lines 11-17, lines 32-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Korpela with Naghian, in order to determine whether the identified mobile is still connected to the voice channel of the system for the purpose of

Art Unit: 2686

detecting fraud. In order to determine a bill which is proportional to the transformed amount of payload data.

Response to Arguments

7. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. **Any responses to this action should be mailed to:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 703-308-7159. The examiner can normally be reached on 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold be reached (703) 305-4379.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

January 6, 2005

MELODY MEHRPOUR
REGISTERED

